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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 38
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Team Law, Inc.
v.
Stephen A. Spinelli

Cancellation No. 27,366

Charles P. Kennedy of Lerner, David, Littenberg, Krumholz & Mentlik, LLP for Team Law, Inc.

Stephen A. Spinelli, Esq., pro se¹

Before Simms, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 5, 1998 Team Law, Inc. (a New Jersey corporation) filed a petition to cancel Registration No. 1,896,599 on the Principal Register, owned by Stephen A. Spinelli (a lawyer whose office is in Brooklyn, New York), for the mark 1-800-LAW TEAM for "legal services, and promoting public awareness of the need for legal services."²

¹ Respondent, who is an attorney, is appearing pro se in this matter. The Board notes that occasionally papers filed on respondent's behalf were signed by "Vesna Antovic, Esq." listing the same address as that of respondent.

² Registration No. 1,896,599, issued May 30, 1995. The claimed date of first use is November 5, 1990.

As grounds for cancellation petitioner alleges that since at least as early as October 1987 petitioner, through its predecessor, has used the marks TEAM-LAW and 1-800-TEAM-LAW as trade names and as service marks in connection with legal services; that, through assignment, petitioner owns Registration No. 1,981,924 for the mark TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED for legal services³; that petitioner owns application Serial No. 74/529,875⁴ for the mark TEAM-LAW for legal services, and the Trademark Examining Attorney has refused registration to petitioner based on respondent's registration; that respondent's mark, when used in connection with his services, so resembles petitioner's previously used marks and trade names, as well as its registered mark, as to be likely to cause confusion, mistake or deception; and that from the date of issuance of the registration of the mark 1-800-LAW TEAM, and continuing to the present, respondent has not used his mark and has abandoned his rights thereto.

Respondent, in his answer, denies the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration; the testimony, with exhibits, of

³ Registration No. 1,981,924, issued June 25, 1996. The words "lawyers for the seriously injured" are disclaimed. The claimed date of first use is 1991.

⁴ The records of this Office indicate that action on petitioner's pending application has been suspended in Law Office 103.

Kenneth S. Oleckna, Esq., one of five equal shareholders in petitioner corporation⁵; and petitioner's two notices of reliance. Respondent offered no evidence or testimony.

Both parties filed briefs on the case.⁶ An oral hearing was requested, but, after an oral hearing was scheduled, both respondent and petitioner advised the Board that they would not attend. Thus, no oral hearing was held in this case.

The record shows that petitioner's predecessor, the law firm of Ravich, Koster, Tobin, Oleckna, Reitman & Greenstein (hereinafter the Ravich law firm) first used the marks 1-800-TEAM-LAW and TEAM-LAW in about 1985, and first used TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED in 1987, all for legal services. Petitioner corporation, Team Law, Inc., was formed in 1995 by five equal shareholders, and the Ravich law firm assigned its rights to the marks TEAM-LAW, 1-800-TEAM-LAW and TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED to petitioner for the purpose of having petitioner corporation license the marks to various law firms. Under a license, the Ravich law firm has continued using and advertising the TEAM-LAW marks.

⁵ Respondent did not attend Mr. Oleckna's testimony deposition.

⁶ Factual statements made in briefs on the case can be given no consideration unless they are supported by evidence properly introduced at trial. See *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); and *Abbott Laboratories v. TAC Industries, Inc.*, 217 USPQ 819 (TTAB 1981). See also, TBMP §706.02.

Petitioner advertises on billboards and buses; in magazines such as regional East Coast editions of Time, Newsweek, and Sports Illustrated; in newspapers; in yellow pages classified ads; and on television and radio. Some illustrative examples are shown below:

1987 Newspaper Ad

1992 Newspaper Ad

1993 Billboard

1998 Billboard

1992 Yellow Pages Ad

Petitioner's advertising costs under these marks for the years 1987-1997 total approximately \$8,500,000.

The information on respondent comes essentially from the application file which matured into the registration now the subject of this petition to cancel. Mr. Spinelli offers legal services from his office in Brooklyn, New York, and filed his application on August 31, 1993, with specimens showing "1 (800)LAW TEAM" typed onto his letterhead stationery.

Petitioner's current status and title copy of its pleaded Registration No. 1,981,924 (for the mark TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED), submitted under a notice

of reliance, establishes petitioner's standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Petitioner (through its predecessor) has clearly established its prior and continuous use of the common law service marks TEAM-LAW and 1-800-TEAM-LAW since about 1985, and of the registered mark TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED since 1987. Absent proof of first use, respondent is only entitled to the filing date of his application. See Trademark Rule 2.122(b)(2). Petitioner's first use of its marks precedes respondent's filing date in 1993.

Turning to the pleaded ground of likelihood of confusion, our determination of this issue is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

The first du Pont factor we consider is the marks. When considering the involved marks, we must analyze the similarities/dissimilarities as to sound, appearance, connotation and commercial impression. We find respondent's mark 1-800-LAW TEAM similar to petitioner's common law marks

TEAM-LAW and 1-800-TEAM-LAW in all of the relevant categories. Of course, the commercial impression created by the marks must be determined in relation to the services in connection with which the marks are used. Also, the reversal in one mark of the essential elements of another mark will avoid a finding of likelihood of confusion only if the transposed marks create distinctly separate and different commercial impressions. See *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988); and *In re Wm. E. Wright Co.*, 185 USPQ 445 (TTAB 1975). The commercial impression of petitioner's marks TEAM-LAW and 1-800-TEAM-LAW, and respondent's mark 1-800-LAW TEAM are the same. Specifically, both parties' marks connote that when you hire a lawyer, you are getting a team of lawyers to represent your side. The transposition of the words LAW TEAM and TEAM LAW simply does not avoid a likelihood of confusion.

Furthermore, the emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, and the average person is not infallible in his recollection of marks and may well transpose the two elements of the marks in his mind, particularly considering memory over a period of time. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Next, we consider the similarity/dissimilarity of the parties' services and the channels of trade. In this case, both parties provide "legal services." Inasmuch as the respective services are identical, they obviously would be offered through the same, normal channels of trade to all the usual purchasers for such services. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Even if we assume that the purchasers of legal services exercise at least some degree of care in choosing a lawyer/law firm, they are still likely to be confused as to the source of two such services when both are identified by very similar marks. That is, such purchasers and users are not immune from confusion as to the origin of the respective services, especially when sold under very similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992); and *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1451 (TTAB 1986).

On balance, and considering all of the evidence on the relevant du Pont factors, we find that confusion is likely between respondent's registered mark 1-800-LAW TEAM and petitioner's common law marks TEAM-LAW and 1-800-TEAM-LAW.⁷

⁷ In light of our finding of a likelihood of confusion between respondent's mark 1-800-LAW TEAM and petitioner's common law marks, TEAM-LAW and 1-800-TEAM-LAW, for identical services, we

Finally, turning to the issue of abandonment of respondent's mark, petitioner bears the burden of proof, and must establish abandonment by a preponderance of the evidence. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:41 (4th ed. 2000).

Petitioner essentially contends that respondent has not used his mark since 1993, as evidenced by respondent's answers to certain document requests⁸, and by respondent's failure to submit any evidence of use of his mark for six years.

Petitioner's document request No. 2 reads as follows: "All documents which refer or relate to any advertising or sales for Respondent's services bearing Respondent's Mark since the date of first use"; and respondent answered "Enclosed are copies of the following documents: [a list of 5 letters on respondent's letterhead stationery, all dated in August 1993]."

need not reach the question of likelihood of confusion between respondent's mark and petitioner's registered mark TEAM-LAW LAWYERS FOR THE SERIOUSLY INJURED.

⁸ Normally documents produced by the adverse party in response to a request for production of documents may not be made of record through a notice of reliance. See TBMP §711. However, respondent made no objection to petitioner's notice of reliance on that basis, thereby waiving such objection. Accordingly, we have considered petitioner's notice of reliance on its involved document requests, and respondent's answers thereto.

The problem with petitioner's position on the issue of abandonment is that the sparse evidence before us does not establish abandonment of the mark 1-800-LAW TEAM by respondent for the services identified in his registration. Respondent is not obligated to submit evidence of use, rather, petitioner must establish respondent's abandonment of his mark. Petitioner would have us presume that the documents produced by respondent were all the documents he possessed regarding the involved mark, but respondent could have provided representative samples of documents in answer to petitioner's involved document request. We cannot make such presumptions in determining the issue before us. Petitioner has not established respondent's abandonment of the mark for three years.⁹ Because petitioner did not establish the statutory prima facie three years non-use, petitioner must then prove respondent's intent not to resume use. There is no evidence of record regarding respondent's intent.

Petitioner's evidence fails to establish respondent's abandonment of his mark.

Decision: The petition to cancel is denied on the ground of abandonment, and it is granted on the ground of

⁹ If petitioner had established a prima facie showing of non-use by respondent for three years, then respondent's intent not to resume use would have been inferred under Section 45 of the Trademark Act.

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priority and likelihood of confusion. Accordingly,
Registration No. 1,896,599 will be cancelled in due course.